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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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26781	7590	02/15/2006	EXAMINER	
BROUSE MCDOWELL LPA 388 SOUTH MAIN STREET SUITE 500 AKRON, OH 44311			RINES, ROBERT D	
			ART UNIT	PAPER NUMBER
			3626	

DATE MAILED: 02/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/954,927	PORTERFIELD, JAMES A.	
	Examiner	Art Unit	
	Robert D. Rines	3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 September 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/18/01</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant

[1] This communication is in response to the patent application filed 18 September 2001. It is noted that this application benefits from Provisional Patent Application Serial No. 60/255,440 filed 14 December 2000. The IDS statement filed 18 December 2001 has been entered and considered. Claims 1-20 are pending.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

[2] Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

[A] Claims 1 and 3 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP

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§ 2172.01. As written, both claims 1 and 3 introduce the limitations/method steps or: "providing expected payment" and "providing at least one payer restrictions". Although claim 1 "analyzes" the "expected payment" and the "at least one payer restrictions", it is unclear how such analysis is determinate or contributes to the functional result of "suggesting a billing scenario". Claim 3 fails to analyze or utilize the "expected payment" or "payer restrictions" in any manner at all. Further, in claim 3, the applicant further includes the limitation of "providing at least one relative value unit". Similarly, it is unclear how the relative value unit has any bearing on the function step of "converting the at least one clinical treatment code into at least one billing code".

[B] In claim 2 of the present case, the applicant recites the phrase "best billing scenario" (Claim 2; line 8). The term "best" is a relative term and is undefined regarding its meaning. It is unclear as to whether the applicant intends to determine the maximum allowable reimbursement from an insurance company or other payer or whether the applicant is talking about a payment plan with the patient. For purposes of applying art, the examiner assumes the applicant is intending to maximize reimbursement for procedures performed. Therefore, claim 2 is rejected under 35 U.S.C. 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention.

[C] Claims 12 and 13, when analyzed in the same manner described above with respect to claims 2 and 3 respectively, are also rejected under 35 U.S.C. 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention.

[D] Claims 4-11 and 14-20, by virtue of their dependence on claims 2-3 and 12-13 respectively, and when analyzed in the same manner described with respect to claims 2-3 and 12-13, also fail to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. Therefore, claims 4-11 and 14-20 are rejected under 35 U.S.C. 112 as well.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

[3] Claims 2 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Dorne (United States Patent #5,325,293).

[A] As per claim 2, Dorne teaches a method of determining a medical billing scenario, the method comprising the steps of: providing a logic (Dorne; Abstract, col. 3, lines 32-39 and col. 12, lines 20-50); providing at least one clinical treatment code (Dorne; col. 3, lines 30-35); weighting a treatment (Dorne; col. 15, lines 65-68 and col. 18, lines 8-20); entering the treatment weighting and the clinical treatment code into the logic (Dorne; col. 12, lines 20-50);

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and, determining the best billing scenario based on the treatment weighting and the clinical treatment code (Dorne; col. 3, lines 23-28 and col. 16, lines 1-8).

[B] Claim 12 differs from method claim 2 by reciting "A computer readable medium for implementing a method..." within its preamble. As per this element, Dorne teaches enabling the Dorne method using a computer program stored on a computer readable medium (Dorne; col. 3, lines 40-50).

[i] The remainder of claim 12 repeats the same limitations of method claim 2, and is therefore rejected for the same reasons given for claim 2.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

[4] Claim 1, 3-8, 10-11, 13-17, and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dorne (United States Patent #5,325,293) in view of Giannini (United States Patent #5,915,241).

[A] As per claim 1, Dorne teaches providing a logic (Dorne; col. 3, lines 32-39 and col. 12, lines 20-50); providing at least two clinical treatment codes (Dorne; col. 3, lines 30-35); providing at least one payer restriction (Dorne; col. 15, line 68 and col. 16, lines 1-8); providing at least one relative value unit (Dorne; col. 7, lines 17-24); providing a weighting value system based on certain criteria (Dorne; col. 15, lines 65-68 and col. 18, lines 8-20); evaluating treatments based upon the value system (Dorne; col. 15, lines 65-68 and col. 18, lines 8-20); assigning a weighting value to each treatment (Dorne; col. 15, lines 65-68 and col. 18, lines 8-20); entering the treatment weighting, the clinical treatment codes, and the relative value unit into the logic (Dorne; col. 12, lines 20-50); analyzing the treatment weighting, the clinical treatment codes, the relative value unit, and the payer restriction (Dorne; col. 12, lines 20-50 and col. 16, lines 1-8); converting the clinical treatment codes into billing codes (Dorne; Abstract and

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col. 3, lines 35-39); and, suggesting a billing scenario based on the relative value unit, and the payer restriction (Dorne; col. 3, lines 23-28).

[i] Although Dorne applies his method for correlating medical procedures and medical billing codes to radiology practice, Dorne indicates that it should be understood that the invention could be used for other medical procedures (Dorne; col. 19, lines 7-14). Nevertheless, Dorne fails to expressly disclose that the invention used with respect to physical therapy practice. Further, although the invention of Dorne is directed to translating procedures into billing codes in such a way as to maximize the procedure billed (Dorne; col. 3, lines 23-28) and by way of calculation derives an "expected payment" (Dorne; col. 16, lines 1-9), Dorne fails to expressly teach that an expected payment is entered into the method prior to the billing step.

[ii] However, Giannini teaches a method for processing healthcare provider billing that is directed to physical therapy practice (Giannini; Abstract and col. 6 - TABLE). Giannini further enters an expected payment into the logic component of the method (Giannini; col. 4, lines 54-61 and col. 8, lines 39-44).

[iii] It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Dorne with those of Giannini. The motivation to combine the teachings would have been to optimizing the billing for physical therapy procedures (Giannini; col. 6 - TABLE) such that the medical professional performing the procedures would receive the maximum payment for the most complicated or highest ranked treatment in a series

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or group or treatments (Dorne; col. 15, lines 65-68 and col. 16, lines 1-8). Further motivation to combine would have been to derive cost averages or expected payments for physical therapy procedures from aggregate provider fee information such that an industry cost average could be determined based on the scope of practice, specialty, and location information of the provider (Giannini; col. 7, lines 38-44 and col. 8, lines 39-44).

[B] As per claim 3, Dorne teaches the steps of: providing at least one payer restriction (Dorne; col. 15, line 68 and col. 16, lines 1-8); providing at least one relative value unit (Dorne; col. 7, lines 17-24); and, converting the at least one clinical treatment code into at least one billing code (Dorne; Abstract and col. 3, lines 29-39); Giannini and Dorne teach providing expected payments (Giannini; col. 8, lines 39-44 and Dorne; col. 3, lines 23-29 and col. 16, lines 1-8 *see analysis claim 1).

[C] As per claim 4, Dorne teaches determining the best billing scenario (Dorne; col. 16, lines 1-8) based on the treatment weighting and the clinical treatment code comprises the step of: determining the best billing scenario based on the treatment weighting (Dorne; col. 15, lines 65-68 and col. 18, lines 18-20), the clinical treatment code (Dorne; col. 3, lines 30-35), the at least one payer restriction (Dorne; col. 15, line 68), the relative value unit (Dorne; col. 7, lines 17-24), and the expected payments (Dorne; col. 3, lines 23-29, col. 16, lines 1-8 and Giannini; col. 4, lines 54-61, col. 8, lines 39-44, *see analysis claim 1).

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[D] As per claim 5, Dorne and Giannini teach determining the best billing scenario comprises the step of: suggesting a billing code based on the internal expected payment (Dorne; col. 3, lines 23-29, col. 16, lines 1-8 and Giannini; col. 4, lines 54-61, col. 8, lines 39-44, *see analysis claim 1).

[i] Regarding claims 3-5, the obviousness and motivation to combine as discussed with regard to claim 1 above are applicable to claim 3-5 and are herein incorporated by reference.

[E] As per claim 6, Dorne teaches weighting a treatment comprises the steps of: providing a weighting value system based on certain criteria (Dorne; col. 15, lines 65-68, col. 16, lines 1-8 and col. 18, lines 8-20); evaluating treatments based upon the value system (Dorne; col. 15, lines 65-68, col. 16, lines 1-8 and col. 18, lines 8-20); and, assigning a weighting value to each treatment (Dorne; col. 15, lines 65-68, col. 16, lines 1-8 and col. 18, lines 8-20).

[F] As per claim 7, Dorne teaches providing a visit slip (Dorne; col. 5, lines 5-16, col. 5, lines 28-35, col. 7, lines 49-53, and col. 8, lines 10-16), the visit slip containing clinical information (Dorne; col. 7, lines 49-53); and, converting the clinical information into billing language (Dorne; col. 9, lines 13-28 and col. 10, lines 16-23). NOTE: while Dorne does not utilize the term "visit slip", Dorne creates an "examination record" that is saved (Dorne; col. 16, line 62) and later converted into billing language for billing purposes. The examiner is interpreting the "examination record" of Dorne as analogous to the "visit slip" of the present application.

[G] As per claim 8, Gianinni teaches accessing a database through a global computer network (Gianinni; Abstract and col. 4, lines 30-40); and Dorne teaches accessing a patient account (Dorne; col. 6, lines 5-17).

[i] Regarding claim 8, the obviousness and motivation to combine as discussed with regard to claim 1 above are applicable to claim 8 and are herein incorporated by reference.

[H] As per claim 10, Gianinni teaches analyzing past charging behaviors (Gianinni; col. 5, lines 50-55 and col. 8, lines 39-43); and both Gianinni and Dorne teach determining expected payment (Dorne; col. 3, lines 23-29, col. 16, lines 1-8 and Gianinni; col. 4, lines 54-61, col. 8, lines 39-44, *see analysis claim 1).

[i] Regarding claim 10, the obviousness and motivation to combine as discussed with regard to claim 1 above are applicable to claim 10 and are herein incorporated by reference.

[J] As per claim 11, Dorne teaches the method further comprises the steps of: creating reports based on the visit slip (Dorne; col. 9, lines 13-19); and, utilizing the reports to define and quantify clinical practice (Dorne; col. 9, lines 20-28).

[K] Regarding claims 13-15, claims 13-15 differ from method claims 3, 4, and 6, respectively, by reciting "A computer readable medium for implementing the method" within its preamble. As per this element Dorne teaches enabling the Dorne method using a computer

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program stored on a computer readable medium (Dorne; col. 3, lines 40-50). Similarly, Giannini teaches enabling the Gianinni enabling the Giannini method via a computer program or computer programs stored on a computer readable medium (Gianinni; col. 10, lines 37-41 and col. 11, lines 48-63).

[i] The remainders of claims 13-15 repeat the same limitations of method claims 1 and 3-6, and are therefore rejected for the same reasons given for claim 1 and 3-6.

[L] Claim 16 differs from method claim 7 by reciting "The computer readable medium..." within its preamble. As per this element Dorne teaches enabling the Dorne method using a computer program stored on a computer readable medium (Dorne; col. 3, lines 40-50).

[i] The remainder of claim 16 repeats the same limitations of method claim 7, and is therefore rejected for the same reasons given for those claim 16.

[M] Claim 17 differs from method claim 8 by reciting "The computer readable medium...." within its preamble. As per this element Dorne teaches enabling the Dorne method using a computer program stored on a computer readable medium (Dorne; col. 3, lines 40-50). Similarly, Giannini teaches enabling the Gianinni enabling the Giannini method via a computer program or computer programs stored on a computer readable medium (Gianinni; col. 10, lines 37-41 and col. 11, lines 48-63).

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[i] The remainder of claim 17 repeats the same limitations of method claim, and is therefore rejected for the same reasons given for those claims.

[N] Claim 19 differs from method claim 10 by reciting "The computer readable medium...." within its preamble. As per this element Dorne teaches enabling the Dorne method using a computer program stored on a computer readable medium (Dorne; col. 3, lines 40-50). Similarly, Giannini teaches enabling the Gianinni enabling the Giannini method via a computer program or computer programs stored on a computer readable medium (Gianinni; col. 10, lines 37-41 and col. 11, lines 48-63).

[i] The remainder of claim 19 repeats the same limitations of method claim 10, and is therefore rejected for the same reasons given for those claims.

[O] Claim 20 differs from method claim 11 by reciting "the computer readable medium..." within its preamble. As per this element Dorne teaches enabling the Dorne method using a computer program stored on a computer readable medium (Dorne; col. 3, lines 40-50).

[i] The remainder of claim 20 repeats the same limitations of method claim 11, and is therefore rejected for the same reasons given for those claims.

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[5] Claims 9 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dorne and Gianinni as applied to claim 1 above, and further in view of Abbo (United States Patent Application Publication #2003/0195774).

[A] As per claim 9, Dorne teaches providing a visit slip (Dorne; col. 5, lines 5-16, col. 5, lines 28-35, col. 7, lines 49-53 and col. 8, lines 10-16 *see analysis claim 7), the visit slip containing clinical information (Dorne; col. 7, lines 49-53); and, utilizing the visit slip to document services provided (Dorne; col. 7, lines 49-53) Dorne fails to teach time in an associated clinic or alterations in an associated patient's condition.

[i] However, Abbo teaches accounting for time in an associated clinic (Abbo; paragraph [0106]) and Abbo teaches monitoring alterations in an associated patient's condition (Abbo; paragraphs [0005] [0007] [0008] [0009]).

[ii] It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Dorne and Gianinni with those of Abbo. Such combination would have resulted in a medical practice management method capable of correlating performed medical procedures with billing codes to maximize procedures billed (Dorne; col. 3, lines 23-29) while tracking related items such as time per patient visit and improvement or changes in a patient's health based on past medical history and current visit diagnosis and lab results (Abbo; paragraph [0007] [0008] [0009])). The motivation to combine the teachings would have been to create a comprehensive, integrated computer program

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application and system to manage multiple aspects of a medical practice (Abbo; paragraph [0005]).

[B] Claim 18 differs from method claim 9 by reciting "The computer readable medium..." within its preamble. As per this element Dorne teaches enabling the Dorne method using a computer program stored on a computer readable medium (Dorne; col. 3, lines 40-50). Similarly Abbo teaches enabling the Abbo method via a computer program or computer programs stored on a computer readable medium (Abbo; paragraph [0005]).

[i] The remainder of claim 18 repeats the same limitations of method claim 9, and is therefore rejected for the same reasons given for claim 9.

Conclusion

[6] The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Waters et al., SYSTEM AND METHOD FOR OPTIMIZING MEDICAL DIAGNOSIS, PROCEDURES AND CLAIMS USING A STRUCTURED SEARCH SPACE, United States Patent #6,393,404

Gilbert, METHOD, APPARATUS, AND DATA STRUCTURE FOR CAPTURING AND REPRESENTING DIAGNOSTIC, TREATMENT, COSTS, AND OUTCOMES INFORMATION IN A FORM SUITABLE FOR EFFECTIVE ANALYSIS AND HEALTH CARE GUIDANCE, United States Patent #6,381,576

Chapman et al., METHOD OF ADJUDICATING MEDICAL CLAIMS BASED ON SCORES THAT DETERMINE MEDICAL PROCEDURE MONETARY VALUES, United States Patent #6,879,959

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert D. Rines whose telephone number is 571-272-5585. The examiner can normally be reached on 8:30am - 5:00pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 571-272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

R.D.R.

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11/28/05

C. Luke Gilligan
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PATENT EXAMINER